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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/243,008	02/02/1999	BRIAN SEED	00786/270002	1831

7590 07/03/2002
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EXAMINER

NOLAN, PATRICK J

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 07/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/243,008

Applicant(s)
Seed et al.

Examiner
Patrick J. Nolan

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 2, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-47, 51, 52, 56, 57, 60-64, 66, 68, 70, 72-75, 77, 79-82, and 1 is/are pending in the application.
- 4a) Of the above, claim(s) 56, 57, 60-64, 66, 68, 70, 77, 80-82, and 92-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-47, 51, 52, 72-75, 79, 100, and 101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Part III DETAILED ACTION

1. This application is a continuation of 08/394,176 which is continuation-in-part of 08/203,866 which is a continuation of 07/847,566 which is continuation-in-part of 07/665,961.

2. Claims 44-47, 51-52, 56-57, 60-64, 66, 68 70, 72-75, 77, 79-82 and 92-101 are pending.

3. Claims 56-57, 60-64, 66, 68, 70, 77, 80-82 and 92-99 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions, for reasons supplied in Paper No.8 .

4. Claims 44-47, 51-52, 72-75, 79 and 101 may not have the benefit under **35 USC § 120** of the parent filing dates (2/28/94, 3/06/92, and 3/07/91), because the claimed chimeric receptors, specifically an intracellular CD28 portion, are not disclosed in the parent applications, serial numbers 08/203,866, 07/847,566 and 07/665,961.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 44-47, 51-52, 72-75, 79 and 100-101 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for reasons set forth in Paper No. 20.

Applicant's arguments filed 5-2-02 have been fully considered but are not found persuasive.

First of all it is noted that the declaration submitted 5-2-02 has been fully considered and has overcome the Examiner's assertion that Applicant's one disclosed species may or may not have an intracellular domain that does not signal said cell to destroy a receptor-bound target cell or receptor-bound target infective agent.

The remaining issue is whether Applicant's disclosure of one species, amongst a myriad amount of receptor cell constructs conveys to one of skill in the art at the time of the invention Applicant's presently claimed sub-genus.

To rebut the examiner's position that Applicant does have

support for their claimed invention Applicant makes essentially two arguments: 1) that they have support in their originally filed claims for the claimed invention and 2) the disclosure of one working examples supports their claimed invention.

However, 1) their originally filed claim 44 has only 2 parts to the receptor: A) an extracellular domain and B) an transmembrane domain. There is no recitation of the intracellular domain in the originally filed claims.

2) The disclosure of one working example, a tripeptide intracellular domain, that inherently does not signal said cell to destroy a receptor bound target-cell or receptor-bound target infective agent, does not support a sub-genus claim that in its scope is between original claim 44, where any intracellular domain could be added or not be added and applicants lone working example of a specific receptor construct that has added to it a tripeptide intra-cellular domain that inherently does not signal said cell to destroy a receptor bound target-cell or receptor-bound target infective agent. It is clear that from the multitude of receptor constructs disclosed with the originally filed specification that Applicant's recitation of a cell that has three parts to a receptor, one extracellular domain, one transmembrane domain, and any intracellular domain that does not signal said cell to destroy a receptor bound target-cell or receptor-bound target infective agent, was not part of Applicant's originally filed disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

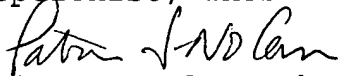
9. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any

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inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.



Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
July 2, 2002